

Claims 1, 25, and 49 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential structural cooperative relationships of elements.

Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman et al. (U.S. Patent No. 6,317,761) (“Landsman”) in view of Eilbott et al. (U.S. Patent No. 6,553,393) (“Eilbott”).

Claims 14, 15, 38, 39, 63, and 64 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Ackermann, Jr. et al. (U.S. Patent No. 6,606,653) (“Ackermann”).

Claims 20, 44, and 68 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Underwood (U.S. Patent No. 6,704,873) (“Underwood”).

Claims 21-23, 45-47, and 69-71 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Markus (U.S. Patent No. 6,499,042) (“Markus”).

Claims 24, 48, and 72 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Shapiro et al. (U.S. Patent No. 5,991,810) (“Shapiro”).

THE REJECTIONS NOT BASED ON THE PRIOR ART

35 U.S.C. §112, first paragraph

Claims 1, 25, and 49 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office Action alleged that

the specification does not disclose that the porthole engine responds to an initial request before the requested content is requested from the origin server, as recited in Claims 1, 25, and 49.

FIG. 3 of the present application shows step 2 occurring before step 4. In step 2, porthole engine 30 responds to the initial request of client 10. Later (as is clear from the sequential enumeration of the steps), in step 4, porthole engine 30 forwards a request for the requested content to origin servers 40. These steps are further described on pages 14-15 of the specification. In fact, on page 14, lines 17-18, the specification says, “FIG. 3 shows the **event sequences** for frame-wrapping...” Thus, the specification clearly describes a sequence of events in which the porthole engine responds to an initial request before the requested content is requested from the origin server.

Therefore, the specification contains a written description of the inventions claimed in Claims 1, 25, and 49, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains to make and use those inventions. Consequently, withdrawal of the rejections of Claims 1, 25, and 49 under 35 U.S.C. §112, first paragraph, is respectfully requested.

35 U.S.C. §112, second paragraph

Claims 1, 25, and 49 also were rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential structural cooperative relationships of elements. Specifically, the Office Action alleged that Claims 1, 25, and 49 omitted an allegedly required limitation that recited how it is possible for the porthole engine to respond to an initial request and generate data without the request being sent to the origin server to collect the requested content.

Claims 1, 25, and 49 recite all essential structural cooperative relationships between the elements recited therein. These claims recite interactions between a client, a porthole engine, and an origin server. No essential structural cooperative relationship has been omitted from these claims. The specification does not indicate that any element not recited in these claims is essential.

Although the Office Action alleges that 35 U.S.C. §112, second paragraph, requires that the claims recite “how it is possible” for something to be done, there is no legal requirement set forth in the language of 35 U.S.C. §112, or in any of the known cases interpreting that statute, that a claim must recite “how it is possible” for something to be done. MPEP 2172.01 does not set forth any such requirement.

The specification recites, on pages 14-15, an embodiment of the invention in which a client sends an initial request to a porthole engine, and the porthole engine responds to the initial request by generating user frameset data and sending the user frameset data back to the client. In such an embodiment of the invention, the user frameset data includes tags for embedded items. When the client receives the user frameset data from the porthole engine, the client’s browser decodes the tags. This causes the client’s browser to request data from origin servers 40. Thus, the specification discloses “how it is possible” for the porthole engine to respond to an initial request and generate data before a request is sent to the origin server.

This is but one embodiment of the invention, however. Others are possible. It is not legally necessary for the claims to recite every detail of every embodiment of the invention that is disclosed in the specification. Indeed, if there were such a legal requirement, then there would be no need for the claims, as the claims would have to contain every detail disclosed in the specification, and the claims and the specification would be identical. Clearly, it is legally

permissible for claims to omit some details that are recited in the specification without running afoul of the mandate of 35 U.S.C. §112.

35 USC §112, second paragraph, does not require that Claims 1, 25, and 49 recite how it is possible for the porthole engine to respond to an initial request and generate data without the request being sent to the origin server to collect the requested content. Indeed, Claims 1, 25, and 49 do not expressly recite that the porthole engine responds to an initial request and generates data **without** the request being sent to the origin server. In contrast, these claims recite that the porthole engine responds to an initial request **before** the requested content is requested from the origin server. A careful reading of these claims reveals that these claims do not even require that the data generated by the porthole engine in response to the initial request be the same as the requested content.

The specification discloses how it is possible for a porthole engine to respond to an initial request before requested content is requested from an origin server. There is no legal requirement that the claims recite this. Consequently, withdrawal of the rejections of Claims 1, 25, and 49 under 35 U.S.C. §112, second paragraph, is respectfully requested.

THE REJECTIONS BASED ON THE PRIOR ART

Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67

Claims 1-13, 16-19, 25-37, 40-43, 49-62 and 65-67 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman in view of Eilbott. However, as was explained in the reply to the previous Office Action, Claim 1 recites that a porthole engine responds to an initial request by sending, to a client, data generated by the porthole engine **before** requested content is requested from an origin server. Although the Office Action

alleges that the combination of Landsman and Eilbott teaches or suggests several aspects of Claim 1, the Office Action **does not even allege** that either Landsman or Eilbott, taken alone in combination, discloses that a porthole engine responds to an initial request by sending, to a client, data generated by the porthole engine **before** requested content is requested from an origin server.

Indeed, there is no teaching or suggestion, in either Landsman or Eilbott, that a proxy server (the alleged porthole engine) sends data to a client **before** the proxy server requests data from an alleged origin server. Landsman discloses, at col. 8, lines 17-24, that a request from a client PC is routed to a proxy server, which, in turn, directs that request onward to the advertisement web server. Only **after** the advertisement files have been requested from the advertisement web server and sent to the proxy server does the proxy server provide the advertisement files to the client PC that made the request. There is no mention of the proxy server providing any data other than the advertisement files to the client PC.

Eilbott discloses, at col. 2, lines 23-30, that a proxy server transcodes HTML returned from an origin server, then generates an embedded object reference list, then adds the list to the data stream (the transcoded HTML) that is to be returned to a client, and then returns the data stream to the client. Thus, it is only **after** the proxy server has requested the HTML from the origin server that the proxy server sends the data stream to the client that requested the HTML. There is no mention of the proxy server providing any data other than the data stream to the client.

Thus, neither Landsman nor Eilbott teaches, discloses, or suggests “before the requested content is requested from the origin server, said porthole engine responding to said initial request by sending to said client data generated by the porthole engine wherein the data causes

said requested content and said unrequested content to appear on a display screen of said client” as recited in Claim 1. In order for a *prima facie* case of obviousness to be established under 35 U.S.C. 103, the combined references must, at least when considered in combination, teach or suggest all of the limitations of the claims that are alleged to be obvious. Even assuming, *arguendo*, that Landsman and Eilbott could be combined, Landsman and Eilbott still do not teach, disclose, or suggest all of the limitations of Claim 1. Thus, Claim 1 is patentable over Landsman and Eilbott, taken individually or in combination.

Claim 25 is a “computer readable medium” version of Claim 1. Claim 49 is a system claim with limitations similar to those described above with reference to Claim 1. The remaining claims depend, directly or indirectly, on Claims 1, 25, or 49. Therefore, all of the remaining claims are patentable over Landsman and Eilbott, taken individually or in combination, for the reasons given above with respect to Claim 1. In addition, each of these claims includes one or more additional limitations that independently render it patentable over the art of record.

Claims 14, 15, 38, 39, 63, and 64

Claims 14, 15, 38, 39, 63, and 64 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Ackermann. By virtue of their dependence from Claim 1, Claims 14 and 15 include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eilbott, fails to teach or suggest at least one limitation required by Claim 1. The Office Action does not even allege that Ackermann teaches or suggests these missing limitations. Thus, Claims 14 and

15 are patentable over Landsman, Eilbott, and Ackermann, taken individually or in combination.

Claims 38 and 63 recite similar limitations to Claim 14, except Claim 38 relates to a computer-readable medium and Claim 63 relates to a system. Claims 39 and 64 recite similar limitations to Claim 15, except Claim 39 relates to a computer-readable medium and Claim 64 relates to a system. Therefore, Claims 38, 39, 63, and 64 are also patentable over Landsman, Eilbott, and Ackermann, taken individually or in combination.

Claims 20, 44, and 68

Claims 20, 44, and 68 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Underwood. By virtue of its dependence from Claim 1, Claim 20 includes all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eilbott, fails to teach or suggest at least one limitation required by Claim 1. The Office Action does not even allege that Underwood teaches or suggests these missing limitations. Thus, Claim 20 is patentable over Landsman, Eilbott, and Underwood, taken individually or in combination.

Claims 44 and 68 recite similar limitations to Claim 20, except Claim 44 relates to a computer-readable medium and Claim 68 relates to a system. Therefore, Claims 44 and 68 are also patentable over Landsman, Eilbott, and Underwood, taken individually or in combination.

Claims 21-23, 45-47, and 69-71

Claims 21-23, 45-47, and 69-71 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Markus. Claims 21-23 depend from

Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eilbott, does not teach one or more limitations required by Claim 1. The Office Action does not even allege that Markus teaches or suggests these missing limitations. Therefore, a combination of Markus with Eilbott and Landsman cannot provide all features or steps recited in Claims 21-23.

Claims 45-47 and 69-71 include similar limitations to Claims 21-23, except that Claims 45-47 refer to a computer-readable medium, and Claims 69-71 refer to a system. Therefore, Claims 45-47 and 69-71 are patentable over Landsman, Eilbott, and Markus for at least the reasons provided herein with respect to Claims 21-23.

Claims 24, 48, and 72

Claims 24, 48, and 72 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Landsman and Eilbott in view of Shapiro. Claim 24 depends from Claim 1 and includes all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eilbott, does not teach one or more limitations required by Claim 1. The Office Action does not even allege that Shapiro teaches or suggests these missing limitations. Therefore, a combination of Shapiro with Eilbott and Landsman cannot provide all features or steps recited in Claim 24.

Claims 28 and 72 recite similar limitations to Claim 24, except that Claim 28 refers to a computer-readable medium, and Claim 72 refers to a system. Therefore, Claims 28 and 72 are patentable over Landsman, Eilbott, and Shapiro for at least the reason provided herein with respect to Claim 24.

CONCLUSION

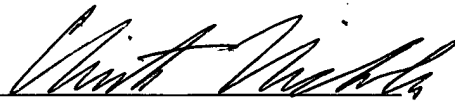
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



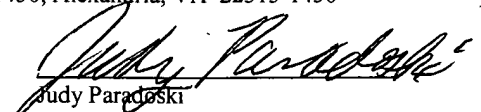
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On September 22, 2005


Judy Paradeski